

--22. (New) The method of claim 1, wherein said inhibitor of elastase-like enzymes is a phosphonic acid compound, or a derivative or salt thereof.--

#### SUPPORT FOR AMENDMENTS

Claims 1, 3, 4, 6 and 22 are now active in this application. Claim 1 has been amended to correct a grammatical mistake and to indicate that the compound used in the present method is not a mercaptopropionamide. New claim 22 has been added which further limits claim 1 by specifying that the compound used in the present method is a phosphonic acid compound, derivative or salt thereof. This is supported by the specification at page 5, lines 2-5. No new matter has been added by these amendments.

#### REQUEST FOR RECONSIDERATION

Applicants' representative would like to thank Examiner Weber for the courteous and helpful discussion of the issues during the discussion held October 21, 2002. The above amendments and following remarks summarize and further expand on the contents of that discussion.

The present invention relates to a method for inhibiting hair growth. The method comprises the topical application of an inhibitor of elastase-like enzymes or a neutral endopeptidase inhibitor. The compound is further required to not be a matrix metalloproteinase inhibitor and is required to not be a mercaptopropionamide compound.

The claims stand rejected for obviousness-type double patenting over either of Claims 1-4 of U.S. Patent 6,171,595 (the '595 patent) or Claim 2 of U.S. Patent 6,375,948 (the '948 patent). The rejection over the '595 patent is hereby obviated by the attached Terminal Disclaimer and should be withdrawn.

The rejection over claim 2 of the '948 patent is respectfully traversed as improper in light of the holding in In re Braat, 19 U.S.P.Q.2d 1289 (Fed. Cir., 1991). In Braat, the issue was whether an application that was first filed, but last to issue (the Braat application) could be properly rejected for double patenting over a second filed but first to issue patent (the Dil patent). The only difference between the claims at issue in that case was that the claims of Braat included a limitation of information areas having side walls which are angled at a specific angle, while the claims of the later filed but first to issue Dil patent did not have such a limitation. The court indicated that in such cases, the Examiner must apply a "two-way obviousness" test, rather than the conventional "one-way obviousness" test, wherein the claims of each application/patent must make the claims of the other obvious.

The present application and the '948 patent are in the same relationship as the Braat application and Dil patent. In particular, the present claims require the use of an inhibitor of elastase-like enzymes or a neutral endopeptidase inhibitor. Claim 2 of the '948 patent requires the same. However, the present claims further require that the compound used does not inhibit MMP's, a requirement nowhere suggested or mentioned by the claims of the '948 patent. Additionally, claim 2 of the '948 patent requires the use of a combination of the elastase inhibitor with an extract of the genus *Juniperus* or a malt selected from wheat malt, barley malt or a mixture thereof, a requirement that cannot be suggested by the claims of the present application. Accordingly, there is not only no two-way obviousness as required by Braat under the present circumstances, there is also no one-way obviousness, as each of the present application and the '948 patent contain limitations that cannot be suggested by the other. As such, the rejection is improper and should be withdrawn.

The claims further stand rejected under 35 U.S.C. 112, first paragraph. During the discussion of October 21, the Examiner indicated that the issue in this rejection is whether the

mercaptopropionamide compounds described in the present application are properly included within the present claims or not, particularly in light of the disclosure of Sundeen et al which is characterized by the Examiner as indicated that such mercaptopropionamides are MMP inhibitors. This rejection has been obviated by the present amendment which excludes mercaptopropionamides from the present claims as permitted by case law. As such, the rejection is believed to be obviated by the present amendment and its withdrawal is respectfully requested.

Applicants also provide herewith an Information Disclosure Statement. Its consideration is also respectfully requested.

Applicants submit that the application is now in condition for allowance, and early notification of such action is earnestly solicited.

Respectfully submitted,

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